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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,793	10/24/2003	Jerome B. Zeldis	9516-080-999	2026

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222 EAST 41ST ST
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EXAMINER

KIM, JENNIFER M

ART UNIT	PAPER NUMBER
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1617

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05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/693,793	Applicant(s) ZELDIS ET AL.	
	Examiner Jennifer Kim	Art Unit 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 3-21, 24, 25 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 22, 23 and 26-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

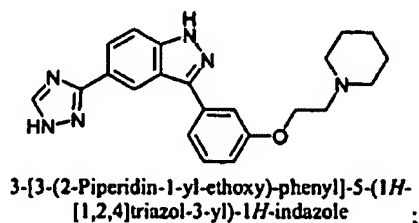
- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/15/05; 2/17/05; 2/15/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicants' election **without traverse** of Group I, claims 1, 2, 5-11, 22, 23 and 26-35 drawn to a method for treating, preventing managing and/or modifying pain in a patient, comprising administering to a patient in need there of an effective amount of a compound having the formula set forth in claims 2, 5-11 and 23 with an election of species of 3-(3-(2-(piperidin-1-yl)ethoxy)phenyl)-5-(1H-1,2,4-triazol-3-yl)-1H-1H-indazole having the following structure:



is acknowledged. Accordingly, claims 3-21, 24, 25 and 36 are withdrawn from consideration since they are non-elected invention.

Claims 1, 2, 22, 23 and 26-35 have been examined only to the extent of applicants' elected species of 3-(3-(2-(piperidin-1-yl)ethoxy)phenyl)-5-(1H-1,2,4-triazol-3-yl)-1H-1H-indazole.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 22, 23 and 26-35 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the "treatment of pain", does not reasonably provide enablement for the "**preventing** pain". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

3. Enablement is considered in view of the Wands factors (MPEP 2164.01(a)). These include: nature of the invention, breadth of the claims, guidance of the specification, the existence of working examples, predictability of the prior art, state of the prior art and the amount of experimentation necessary. All of the **Wands factors** have been considered with regard to the instant claims, with the most relevant factors discussed below.

Nature of the Invention: All of the rejected claims are drawn to a method for treating, preventing, managing and/or modifying pain in a patient, comprising administering to a patient in need thereof an effective amount of a JNK inhibitor or a pharmaceutically acceptable salt, solvate or stereoisomer thereof. The nature of the invention is extremely complex in that it encompasses the actual

prevention of painful disorder (i.e. break through pain, neuropathic pain) such that the subject treated with above compounds does not contract pain.

Breath of the Claims: The complex of nature of the claims greatly exacerbated by breath of the claims. The claims encompass prevention of painful disorder in humans which has potentially many different causes (i.e. many different neuropathy including resulting from chemotherapy or combination of diseases). Each of which may or may not be addressed by the administration of the claimed compounds.

Guidance of the Specification: The guidance given by the specification as to how one would administered the claimed compounds to a subject in order to actually prevent pain is minimal. All of the guidance provided by the specification is directed towards treatment rather than **prevention** of pain.

Working Examples: All of the working examples provided by the specification are directed toward the treatment rather than prevention of pain.

State of the Art: While the state of the art is relatively high with regard to treatment of pain (i.e. cancer pain, lower back pain), the state of the art with regard to prevention of such disorders is underdeveloped. In particular, there do not appear to be any examples or teachings in the prior art wherein a compound similar to the claimed compounds was administered to a subject to prevent development of pain. The state of the art, Shah et al. (U.S. Patent 6,562,033 B2) teaches that making treatment and management of lower back pain is very difficult. (column 1, lines 20-30).

Predictability of the Art: The lack of significant guidance from the specification or prior art with regard to the actual prevention of pain in a human subject with the claimed compounds makes practicing the claimed invention unpredictable in terms of prevention of pain.

The amount of Experimentation Necessary: In order to practice claimed invention, one of skilled in the art would have to first envision a combination of appropriate pharmaceutical carrier, compound dosage, duration of treatment, route of administration, etc. and appropriate animal model system for one of the claimed compounds and test the combination in the model system to determine whether or not the combination is effective for prevention of pain. If unsuccessful, which is likely given the lack of significant guidance from the specification or prior art regard prevention of pain with any compound, one of skill in the art would have to then either envision a modification of the first combination of pharmaceutical compound, compound dosage, duration of treatment, route of administration, etc. and appropriate animal model system, or envision an entirely new combination of the above, and test the system again. If again unsuccessful, which is likely given the lack of significant guidance form the specification of prior art regarding prevention of pain with any compound, the entire, unpredictable process would have to be repeated until successful. Therefore, it would require undue, unpredictable experimentation to practice the claimed invention to prevent the development of pain in a subject by administration of one of the claimed compounds.

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Therefore, a method for treating, **preventing**, managing and/or modifying pain in a patient, comprising administering to a patient in need thereof an effective amount of a JNK inhibitor or a pharmaceutically acceptable salt, solvate or stereoisomer thereof, is not considered to be enabled by the instant specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 28-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagwat et al. (U.S. Patent No. 6,897,231 B2).

Bhagwat et al. teach that Applicants active agent is useful for the treatment of stroke, asthma, osteoarthritis, rheumatoid arthritis and lupus erythematosus, diabetes and cancers of a variety of tissues.

Applicants claiming “complex regional pain syndrome” are “cancer-related pain”; Applicants claiming “nociceptive pain” are “associated” with osteoarthritis and rheumatoid arthritis; Applicants claiming “neuropathic pain” are “associated” with stroke, and diabetic neuropathy.

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Accordingly, above teaching of Bhagwat et al. clearly prevented pain associated with the diseases above by preventing or treating the diseases that causes pain.

Therefore, Bhagwat et al. clearly anticipates Applicants' claiming invention.

Claims 1, 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Bhagwat et al. (U.S. Patent No. 6,897,231 B2) evidenced by Sanders et al. (U.S. patent No. 5,766,605 A) or Mathias (U.S. patent No. 5,434,36A).

Bhagwat et al. teach that Applicants active agent is useful for the treatment and prevention of lupus erythematosus and asthma.

Applicants claiming the treatment/prevention of pain is a "complex regional pain syndrome" as an **autonomic dysfunction**.

Sanders et al. teach that asthma is autonomic dysfunction. (abstract, claim 1)

Mathias teaches that Lupus Erythematosus is an autonomic dysfunction. (column 1, lines 11-20).

Therefore, Bhagwat et al. clearly anticipates Applicants' claiming invention.

Claims 1, 28-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Stein et al. (US 2004/0067953A1).

Stein et al. teach the treatment and prevention of cancer by the administration of an effective amount of Applicant's active agent. (abstract, Figure 6, C).

Applicants claiming "complex regional pain syndrome" are "cancer-related pain".

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Accordingly, above teaching of Stein et al. clearly prevented pain associated with cancer by preventing or treating cancer that causes pain. Therefore, Stein et al. clearly anticipates Applicants' claiming invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 22, 23 and 26-35 rejected under 35 U.S.C. 103(a) as being unpatentable over Stein et al. (US 2004/0067953A1) in view of Graczyk et al. (WO 02/081475 A1).

Stein et al. teach Applicant's active agent is a JNK inhibitor that blocks, reduces or retard the activity of JNK. (abstract, Fig. 6, [0085]-[0086]).

Stein et al. do not teach the treatment of pain.

Graczyk et al. teach that the compounds that inhibit JNK are useful as a medicine to treat JNK mediated disorder such as pain. (abstract, page 51, line 25-29), page 52 line 6-15).

It would have been obvious to one of ordinary skill in the art to employ Applicants' active agent for the treatment of pain because Applicants' active agent is taught by Stein having JNK inhibiting activity and because pain is mediated by JNK.

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One would have been motivated to employ Applicants' active agent for treatment of conditions such as pain that are mediated by JNK pathway in order to achieve an expected benefit of blocking JNK pathway which causes pain. There is an expectation of successfully treating pain by employment of Applicant's active agent because Applicants' active agent is well known by Stein et al. for having JNK inhibiting activity.

For these reasons the claimed subject matter is deemed to fail to patentably distinguish over the state of the art as represented by the cited references. The claims are therefore properly rejected under 35 U.S.C. 103.


None of the claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kim whose telephone number is 571-272-0628. The examiner can normally be reached on Monday through Friday 6:30 am to 3 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jennifer Kim
Patent Examiner
Art Unit 1617

Jmk
April 30, 2007